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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,359	06/11/2001	CheeWai Seetoh	STL9677/40176.0038USU1	3920
23552	7590	12/11/2003	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			KLIMOWICZ, WILLIAM JOSEPH	
			ART UNIT	PAPER NUMBER
			2652	
			DATE MAILED: 12/11/2003	10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/879,359

Applicant(s)

SEETOH ET AL.

Examiner

William J. Klimowicz

Art Unit

2652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-30 is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 9, 2003 (Amendment B) has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Komai (JP 2-166678 A).

As per claim 1, Komai (JP 2-166678 A) discloses an actuator assembly for reading and writing data from and to a data storage disc (4) in a disc drive (1), the actuator assembly (6) comprising: an actuator arm (6) rotatably mounted adjacent the data disc (4), the arm (6) having a top surface (TS) and a bottom surface (BS) and an arm circuit alignment pin (e.g., 27, 28) projecting from one of the surfaces of the actuator arm (6), the actuator arm including a head gimbal assembly support portion (which supports the head gimbal assembly) located at a

Art Unit: 2652

proximate end of the actuator arm (6) (FIGS. 1, 3); and an arm circuit (21) fastened to one of the surfaces of the actuator arm (6), wherein the arm circuit (21) has an arm circuit alignment aperture (e.g., 31, 32) receiving the arm circuit alignment pin (27, 28) to position the arm circuit (21) on one of the surfaces "at the proximate end" of the actuator arm (6). More concretely, the proximate end is broadly considered to be the part of the actuator extending from just forward of the coil (9B) to the portion of the arm connecting to the head gimbal assembly. The "distal end" of the arm is considered to be the part commencing from the coil (9B) to the end of the actuator arm opposite the end where the head gimbal assembly is affixed.

As per claims 2, 7 (and claim 11, *infra*), further comprising a head gimbal assembly (between arm (6) and head (8) - FIG. 3) fastened to the head gimbal assembly support portion of the actuator arm (6), the head gimbal assembly carrying a data transducer (8) for writing and reading data to and from the data disc (4).

As per claim 6, the arm circuit (21) is fastened to the top surface of the actuator arm (6).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komai (JP 2-166678 A).

See the description of Komai (JP 2-166678 A), *supra*.

Art Unit: 2652

As per claim 10, although Komai (JP 2-166678 A) does not expressly show wherein the arm circuit is fastened to the “bottom” surface of the actuator arm (6), it would have been obvious, given the teachings and suggestions of Komai (JP 2-166678 A) as a whole, to one of ordinary skill in the art at the time the invention was made to provide the arm circuit (21) as being attached to the bottom surface of the actuator arm, as opposed to the top surface.

The rationale is as follows: one of ordinary skill in the art would have been motivated to provide the arm circuit of Komai (JP 2-166678 A) as being attached to the bottom surface as opposed to a top surface since the benefits of attaching an arm circuit to a surface of an actuator arm that isn’t located on the actuator side is readily applicable to either the top surface of the bottom surface of an actuator arm. Either surface of the actuator arm (i.e., top or bottom, as opposed to an actuator side surface), provides improved “mounting workability” as disclosed in the abstract of Komai (JP 2-166678 A).

Furthermore, it has been held that the mere rearranging of parts (e.g., in the instant situation rearranging the location of the arm circuit to a bottom surface as opposed to a top surface) of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70 (CCPA 1950).

See the discussion of claim 11, above, previously discussed with reference to claims 2 and 7.

Claims 3, 8, 12, 13, 15 and 17-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komai (JP 2-166678 A) in view of Forbord et al. (US 6,018,439).

See the description of Komai (JP 2-166678 A), *supra*.

Art Unit: 2652

Additionally, as per claims 13 (and 5, *infra*), the arm circuit (21) is located on the “proximate” end of the actuator arm (6).

Additionally, as per claim 15, the top surface (TS) of the actuator arm (6) includes the one or more arm circuit alignment pins (27, 28); the arm circuit (21) mounted to the top surface (TS) of the actuator arm (6) and aligned to an arm circuit mounted position on the top surface of the actuator arm via the arm circuit alignment pins (27, 28) (i.e., the arm circuit (21) is positioned by pins (27, 28) in a mounted position); the head gimbal assembly (FIG. 3, mounted between the transducer (8) and arm (6)) being operably connected to the actuator arm.

Additionally, as per claim 19, an actuator coil (9B) is operably coupled to the actuator arm (6).

Additionally, as per claim 21, the actuator arm (6) includes a pivot bearing support portion (located adjacent pivot bearing (7)) located between the proximate end and the distal end of the actuator arm (6), and the actuator assembly (6) further comprises a pivot bearing (7) coupled directly to the actuator arm (6) at the pivot bearing support portion (portion of arm (6) surrounding pivot bearing (7)).

With regard to claims 3, 8, 12 and 15, although Komai (JP 2-166678 A) does not explicitly depict a gimbal circuit electrically coupled to the arm circuit, such connections are ubiquitous and conventional. As just an example, Forbord et al. (US 6,018,439) discloses a gimbal circuit (214) electrically coupling a data transducer (144) to an arm circuit (220), the gimbal circuit (214) being partially routed along a head gimbal assembly (146) and over a surface of an actuator arm (142) to which the arm circuit (220) is fastened, wherein the head

Art Unit: 2652

gimbal assembly is fixed to a bottom surface of the actuator arm (as per claim 15, as seen in FIG. 5 of Forbord et al. (US 6,018,439)).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the conventional gimbal circuit as disclosed by Forbord et al. (US 6,018,439) to the actuator assembly system of Komai (JP 2-166678 A).

The rationale is as follows: one of ordinary skill in the art would have been motivated to provide the conventional gimbal circuit as disclosed by Forbord et al. (US 6,018,439) to the actuator assembly system of Komai (JP 2-166678 A) in order to provide the requisite electrical connection between an arm circuit and the transducer head, in order to operate the device and send/receive signals from the distally located sensing transducer, as is well known, established and appreciated in the art, as exemplified by Forbord et al. (US 6,018,439) (e.g., COL. 3, lines 11-16).

Additionally as per claims 17, 18 and 22, 23, although Komai (JP 2-166678 A) as applied to Forbord et al. (US 6,018,439) remains silent with respect to the type of connection mounting the head gimbal assembly to the actuator arm (laser-welded per claim 17, or screw mounted as per claim 18) or to the manner in which pivot bearing (7) is secured to the actuator arm (6) (as per claims 22 and 23), Official notice is taken that such head gimbal assembly to actuator arm mountings (i.e., laser-welded or screw mounted) and pivot bearing to actuator arm couplings via adhesive or press-fittings are notoriously old and well known in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the head gimbal assembly of Komai (JP 2-166678 A), as applied to Forbord et al. (US 6,018,439), as being mounted in the manner prescribed by claims 17 and 18 (laser-

Art Unit: 2652

welded or screw mounted) or press-fitting or adhesively mounting the pivot bearing to the actuator arm as per claims 22 and 23, as is conventional.

The rationale is as follows: one of ordinary skill in the art would have been motivated to provide the head gimbal assembly of Komai (JP 2-166678 A), as applied to Forbord et al. (US 6,018,439), as being mounted in the manner prescribed by claims 17 and 18 (laser-welded or screw mounted) or press-fitting or adhesively mounting the pivot bearing to the actuator arm as per claims 22 and 23, as is conventional, in order to mechanically secure the head gimbal assembly to the actuator arm or the pivot bearing (7) to the actuator arm (6) in an expeditious and conventional manner, as is well known, established and appreciated in the art.

Additionally as per claim 20, although Komai (JP 2-166678 A) as applied to Forbord et al. (US 6,018,439) remains silent with respect to adhesively mounting the voice coil (9) to the actuator arm (6), Official notice is taken that such adhesive voice coil to actuator arm mountings are notoriously old and well known in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the voice coil of Komai (JP 2-166678 A), as applied to Forbord et al. (US 6,018,439), as being mounted in the manner prescribed by claim 19 (adhesively), as is conventional.

The rationale is as follows: one of ordinary skill in the art would have been motivated to provide the voice coil of Komai (JP 2-166678 A), as applied to Forbord et al. (US 6,018,439), as being mounted in the manner prescribed by claim 20 (adhesively), as is conventional, in order to mechanically secure the voice coil to the actuator arm in an expeditious and conventional manner, as is well known, established and appreciated in the art.

Claims 4, 5, 9, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komai (JP 2-166678 A) in view of Forbord et al. (US 6,018,439) as applied to claims 3, 8, 12 and 15 above, and further in view of Marazzo (US 5,103,359).

See the descriptions of Komai (JP 2-166678 A) and Forbord et al. (US 6,018,439), *supra*.

As per claims 4, 9, 14 and 16, Komai (JP 2-166678 A) and Forbord et al. (US 6,018,439) do not collectively show the gimbal circuit having an aperture of alignment pin in the manner prescribed by the above noted claims.

Marazzo (US 5,103,359) teaches providing a gimbal circuit (including 53, 40) having a gimbal circuit alignment aperture (41); and a gimbal circuit alignment pin (33) projecting from an actuator arm ((15) via (36)), wherein the gimbal circuit alignment aperture (41) receives the gimbal circuit alignment pin (33) to position the gimbal circuit (40, 53) over a surface of the actuator arm.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the gimbal circuit apertures and associated pins, which extend from an actuator arm, as taught by Marazzo (US 5,103,359), to the apparatus of Komai (JP 2-166678 A) as applied to Forbord et al. (US 6,018,439).

The rationale is as follows: one of ordinary skill in the art would have been motivated to provide the gimbal circuit apertures and associated pins, which extend from an actuator arm, as taught by Marazzo (US 5,103,359), to the apparatus of Komai (JP 2-166678 A) as applied to Forbord et al. (US 6,018,439) in order to “facilitate electrical interconnection” between first and

Art Unit: 2652

second separate connectors along an actuator arm, as taught by Marazzo (US 5,103,359) (see, *inter alia*, abstract of Marazzo (US 5,103,359)).

See the discussion of claim 5, above, previously discussed with reference to claim 13.

Response to Arguments

Applicants' arguments filed September 9, 2003 (Paper No. 7) have been fully considered but they are not persuasive, as applied to claims 1-23.

The Applicants allege that Komai shows the cable part 21A stopping near the pivot location 7, and not being "positioned at the proximate end of the actuator arm." The Applicants then cite specification language referring what is considered to be "the proximate end" ("such as 208"). See page 8 of Paper No. 7.

The Examiner disagrees. More concretely, Komai (JP 2-166678 A) discloses wherein the arm circuit (21) has an arm circuit alignment aperture (e.g., 31, 32) receiving the arm circuit alignment pin (27, 28) to position the arm circuit (21) on one of the surfaces "at the proximate end" of the actuator arm (6). More concretely, the proximate end is broadly considered to be the part of the actuator extending from just forward of the coil (9B) to the portion of the arm connecting to the head gimbal assembly. The "distal end" of the arm is considered to be the part commencing from the coil (9B) to the end of the actuator arm opposite the end where the head gimbal assembly is affixed. Note further that portion (21A) of cable extends toward the head even further toward the proximate end of the actuator arm (for connection to a wire from the head (8)).

Art Unit: 2652

The Applicants' attempt to rely on reference designators in the specific embodiment of the Applicants' figures still does not rise to the level of a "definition."

Even using the Applicants' designator **208** as a "proximate end," it is unclear to where the Applicants intend to demarcate the boundaries of the "proximate end" with regard to structures set forth within the claims. Note that even Applicants' pins are well in back of designator 208 (which references the "proximate end") as seen in Applicants' Figure 2!

More concretely, does the proximate end extend up to designator **206** through designator **132**? Perhaps the extent of the "proximate end" includes a range of designator **230** through to designator **208**, but excludes designator **206**. Moreover still, perhaps the "proximate end" includes the range extent of designator **216** through to designator **206**. In any event, the Applicants (even in their specification) do not identify or define what the range or meaning of a "proximate end" encompasses.

Additionally, preferred embodiments do not limit the claims, unless the claims specifically recite the structure. Moreover, case law is clear that an Applicant is not required to describe in the specification every conceivable and possible future embodiment of his invention. See *SRI Int'l v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1121, 227 USPQ 577, 585 (Fed. Cir. 1985) (en banc). "[I]f structural claims were to be limited to devices operated precisely as a specification-described embodiment is operated, there would be no need for claims. Nor could an applicant, regardless of the prior art, claim more broadly than that embodiment." *Id.* In short, it is the claims that measure the invention, as informed by the specification. "Specifications teach. Claims claim." *Id.* at 1121 n.14, 585 n.14.

Art Unit: 2652

More recently, the U.S. Court of Appeals for the Federal Circuit in a ruling handed down on May 3, 2002 (*CCS Fitness Inc. v. Brunswick Corp.*, 288 F.3d 1359, 62 USPQ2d 1658 (Fed. Cir. 2002))(64 PTCJ 29, 5/10/02) set forth that the heavy presumption that a claim term carries its ordinary meaning is not rebutted by simply pointing to embodiments of the invention disclosed in the specification, i.e., the presumption of ordinary meaning cannot be rebutted simply by pointing to the preferred embodiment or others structures or steps disclosed in the specification or the prosecution history.

In the instant application, there is no indication in the written description that the Applicant, as is required under *CCS Fitness*, “acted as his own lexicographer and clearly set forth a definition the disputed claim term.”

Moreover, the Examiner cannot discern, and Applicants have failed to point out any express disclaimer of a particular meaning of “proximate end ”

Accordingly, the Examiner declines the Applicants’ invitation to restrict the meaning of the claim term based on the description of the preferred embodiments as it relates to a reference designator.

Clearly, the Applicants’ attempt to limit the claim language to the disclosed and/or preferred embodiments is without merit.

As the Examiner has previously maintained, the Applicants argumentatively recite specific structure with regard to a pivot bearing of the actuator arm in reference to what Applicants apparently consider to be the “proximate end.”

Art Unit: 2652

The Examiner maintains that the Applicants' remarks are not commensurate with the invention as claimed. Therefore, limitations contained therein cannot be read into the claims for the purpose of avoiding prior art. *In re Sporck*, 386 F.2d 924, 155 USPQ 687 (CCPA 1968).

Moreover, it is noted that the Applicants have provided no definition in the specification for the term "proximate end" that would lead to an interpretation other than their plain accepted meaning. When not defined in the specification, the words of a claim must be given their plain meaning, i.e., they must be read as they would be interpreted by those of ordinary skill in the art. *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

As has been widely held, claims are to be given their broadest reasonable interpretation during prosecution. See *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *In re Prater*, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969).

Allowable Subject Matter

Claims 24-30 are allowed.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Klimowicz whose telephone number is (703) 305-3452. The examiner can normally be reached on Monday-Thursday (6:30AM-5:00PM).

Art Unit: 2652

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (703) 305-9687. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.


William J. Klimowicz
Primary Examiner
Art Unit 2652

WJK